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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,786	04/11/2001	David J. Diller	1073.060A	4635
20995	7590	04/24/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ZHOU, SHUBO	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	09/832,786	DILLER ET AL.	
	Examiner	Art Unit	
	Shubo (Joe) Zhou	1631	
<b>--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</b>			
<b>THE REPLY FILED 27 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</b>			
<p>1. <input checked="" type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input checked="" type="checkbox"/> The period for reply expires <u>3</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p>			
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>			
<p><b>NOTICE OF APPEAL</b></p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p>			
<p><b>AMENDMENTS</b></p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input checked="" type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: <u>see continuation sheet</u>. (See 37 CFR 1.116 and 41.33(a)).</p>			
<p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p>			
<p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____.</p>			
<p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p>			
<p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input checked="" type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: _____.</p> <p>Claim(s) objected to: _____.</p> <p>Claim(s) rejected: <u>1-5 and 11-17</u>.</p> <p>Claim(s) withdrawn from consideration: _____.</p>			
<p><b>AFFIDAVIT OR OTHER EVIDENCE</b></p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p>			
<p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p>			
<p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p>			
<p><b>REQUEST FOR RECONSIDERATION/OTHER</b></p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see continuation sheet</u>.</p>			
<p>12. <input type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.</p>			
<p>13. <input type="checkbox"/> Other: _____.</p>			

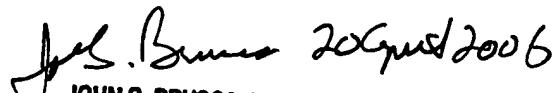
Continuation of item 3a):

The limitation added into claims 1 and 11 reciting rating complementarity of the combinatorial library to the target molecule based "at least in part on the relative number of ligands in the library that are in the largest cluster" raises new issues that require further consideration and/or search because the limitation changes the scope. New limitation "relative number of ligands in the library" in the context of claims 1 and 11 clearly requires further consideration.

Continuation of item 11:

In regard to the rejection of claims 16-17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement regarding the new limitation "counting the number of ligands in at least one cluster and rating complementarity of the combinatorial library to the target molecules based at least in part on the count," applicants argue that since the specification discloses that "the library is ranked according to the relative number of ligands in the top cluster" (paragraph 21), that "the relative number of compounds in the library in the top cluster is a measure of the library's complementarity to the target molecule, and is used to rank the library" (paragraph 66), etc., the specification thus teaches the limitation "counting the number of ligands in at least one cluster and rating complementarity of the combinatorial library to the target molecules based at least in part on the count." This is not persuasive because the specification may disclose counting the number of ligands in at least one cluster and rank libraries therewith, it does not disclose rating complementarity of the library "at least in part of the relative number of ligands in the library that are in the largest cluster."

In regard to the rejection of claims 1-3, 5, 11-13 and 15 under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (1994) in view of Rarey et al., and the rejection of claims 4 and 14 under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (1994) in view of Rarey et al. and Aldenderfer et al., applicants' arguments are based on the newly amended claims. Applicants argue that the cited references do not teach or suggest the newly added limitation "rating complementarity of a combinatorial library based at least in part on the relative number of ligands that are in the largest cluster." This is not persuasive because the amendment has not been entered for reasons set forth above.

  
John S. Brusca 20 August 2006

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PRIMARY EXAMINER